

MARKED-UP COPY OF AMENDED CLAIMS:

1. (Amended) A corpectomy device, comprising:

a) a first member having a longitudinal axis;
b) a second member moveable in an axial direction with respect to said first member; and

c) a locking clip rotatably mounted on one of said first member and said second member so that said locking clip is engagable with the other of said first member and said second member and moveable between a first unlocked position and a second locked position for locking said first member and said second member in a relative axial position with respect to one another.

4. (Twice Amended) A The corpectomy device of claim 1 wherein , comprising:

~~a) a first member having a longitudinal axis;~~
~~b) a second member moveable in an axial direction with respect to said first member; and~~

~~c) a locking clip engagable with said first member and said second member and moveable between a first unlocked position and a second locked position for locking said first member and said second member in a relative axial position with respect to one another;~~

said locking clip and said second member includes interengaging threads for locking said first member and said

second member in a relative axial position with respect to one another, +

 said locking clip being rotatably mounted on said first member for rotation into and out of engagement with said threads.

11. (Twice Amended) ~~A~~ The corpectomy device of claim 1 wherein , comprising:

a) ~~a~~ said first member comprising ~~comprises~~ a hollow member having a longitudinal axis and perforations for permitting ingrowth of bone, blood vessels and other tissue, +

b) ~~a~~ said second member moveable in an axial direction with respect to said first member and having perforations for permitting ingrowth of bone, blood vessels and other tissue, said second member defining a chamber with said first member for movement in said axial direction; and and being slidably and telescopingly received in a passageway of said first member for movement in said axial direction, and

c) ~~a locking clip engagable with said first member and said second member and moveable between a first unlocked position and a second locked position for locking said first member and said second member in a relative axial position with respect to one another,~~

d) ~~said perforations includes:~~

i) elongated perforations extending in the axial direction on one of said first member and said second member; and

ii) substantially circular perforations on the other of said first member and said second member.

26. (Twice Amended) ~~A~~ The corpectomy device of claim 1 wherein ~~, comprising:~~

a) ~~a~~ said first member comprises a hollow, outer tubular member having a longitudinal axis and a passage, ~~+~~

b) ~~a~~ said second member comprises an inner tubular member moveable in an axial direction with respect to said first member, said second member defining a chamber with said first member and being slidably and telescopingly received in said passage of said first member for movement in said axial direction; ~~and~~

c) ~~a locking clip engagable with said first member and said second member and moveable between a first unlocked position and a second locked position for locking said first member and said second member in a relative axial position with respect to one another;~~

said outer tubular member including a wall having an inner surface defining said passage and an outer surface, said outer surface defining a circular cross-sectional shape.

REMARKS

Applicants have amended Claims 1, 4, 11 and 26, the latter three claims being converted back to dependent claims, all depending from claim 1. Applicants elect to prosecute the invention of Species I, Claims 1-15 and 18-33. Species II, Claims 16-17, is thus withdrawn from consideration. Claims 19-24 and 27-33 have been allowed. Accordingly, Claims 1-15, 18, 25 and 26 are presented for the Examiner's reconsideration in view of the following remarks.

In the present Office Action the Examiner has required election between Species I and Species II. Claims 1-15 and 18-33 are readable on Species I, Figures 1-14. Claims 16-17 are readable on Species II, Figures 15-17. As previously mentioned, Applicants elect Species I, Claims 1-15 and 18-33, for consideration.

It is noted that this is the second election requirement, an election between Claims 1-33 and Claims 34-40 having also been required in the First Office Action mailed August 15, 2000. Applicants elected Claims 1-33 in response to that first Office Action.

Applicants submit that the present invention is not shown, described or suggested in any single prior art reference of record. Accordingly, Applicants traverse each anticipation rejection of the claims in light of the above amendments, the following remarks and the requirement in 35

U.S.C. § 102 that a cited reference include each and every element, identically, in the rejected claim.

In the present Office Action, Claims 1, 5, 6, 10, 12, and 13 were rejected under 35 U.S.C. 102 (b) as being anticipated by *Sagger*, U.S. Patent No. 5,702,455 ("*Sagger*"). As these claims contain features not present in *Sagger*, this rejection is respectfully traversed for the following reasons.

Sagger discloses two threaded passages that each engage a third member. A set-screw locks the position of the threaded passages with respect to the third member. However, *Sagger* does not disclose a locking clip having a first locking position and a second unlocked position for locking first and second members in an axial position with respect to one another, as set forth in Claim 1. Claim 1 states "moveable between a first unlocked position and a second locked position." Furthermore, in light of amended Claim 1, *Sagger* does not disclose a "rotatably mounted" locking clip located on one of first member or second member as set forth in Claim 1. Claim 1 states "a locking clip rotatably mounted on one of said first member and said second member." The *Sagger* reference does not include either of the above-mentioned features. Accordingly, independent Claim 1 is not anticipated and is in condition for allowance.

Claims 5, 6, 10, 12 and 13 depend directly or indirectly from Claim 1 and thus are not anticipated by *Sagger* and are otherwise allowable for the same reasons as set forth

above with respect to Claim 1, as well as by reason of the additional features set forth in each of Claims 5, 6, 10, 12 and 13 that are not shown in the prior art of record.

Claims 1, 5-8 and 10 were rejected under 35 U.S.C. 102 (b) as being anticipated by *Daher* U.S. Patent No. 4,657,550 ("*Daher*"). As these claims contain features not present in *Daher*, this rejection is respectfully traversed.

Daher discloses a first and a second member that each engage a third threaded member. Set-screws lock the position of the first and second threaded members with respect to the third member. *Daher*, like *Sagger*, does not disclose a locking clip having a first locking position and a second unlocked position for locking first and second members in an axial position with respect to one another. See the above-quoted language of Claim 1.

Also in light of amended Claim 1, as previously mentioned with reference to *Sagger*, *Daher* does not disclose or suggest a "rotatably mounted" locking clip located on one of the first member or second member, as set forth in Claim 1. See the above-quoted language of Claim 1. Accordingly, independent Claim 1 is not anticipated and is in condition for allowance.

Claims 5-8 and 10 depend directly or indirectly from Claim 1 and thus are not anticipated by *Daher* and are otherwise allowable for the above reasons with respect to

Claim 1, as well as by reason of the additional features therein that are not shown in the prior art of record.

Claims 1, 3-8, 10-15, 18 and 26 were rejected under 35 U.S.C. 102 (e) as being anticipated by *Studer*, U.S. Patent No. 6,193,767 B1 ("*Studer*"). As these claims contain features not present in *Studer*, this rejection is respectfully traversed for the following reasons.

Studer, discloses a first member and a second member slidably received in the first member. *Studer* discloses a locking mechanism comprising multiple spring-loaded protrusions extending inwardly from the first member. The protrusions are never at rest but rather in constant compression, thus they do not have a discrete unlocked position. These protrusions allow the second member to slide within the first member. Upon reaching a desired height, the first member is rotated so that the protrusions engage various orifices contained in the second member, locking the relative positions of the first and second member. The orifices must be large enough as to allow engagement of the protrusions, restricting the variability of the height of the device.

Studer, like *Daher* and *Sagger*, does not disclose a locking clip having a locking position and an unlocking position. While *Studer* discloses a member that rotates from an unlocked position to a locked position, its spring-loaded protrusions do not have a discrete unlocked position, as set forth in Claim 1. See the above-quoted language of Claim 1.

Furthermore, once again in light of the amended Claim 1, Stüder does not disclose a locking clip "rotatably mounted" on one of either first or second member, as set forth in Claim 1. Accordingly, independent Claim 1 is not anticipated and is in condition for allowance.

In light of the above mentioned Claim amendments, Claims 3-8, 10-15, 18 and 26 depend directly or indirectly upon Claim 1. For the above-mentioned reasons, Claims 3-8, 10-15, 18 and 26 are not anticipated by Stüder and are thus allowable. Such dependent claims are also allowable by reason of the additional features therein that are not disclosed in the prior art of record.

Claims 1-9, 13-15, 18, 25 and 26 were rejected under 35 U.S.C. 102 (a) as being anticipated by Schar, Patent Cooperation Treaty No. WO 98/46173 ("Schar"). This rejection is respectfully traversed for the following reasons.

Schar discloses an inner member slidable in an outer member and a split ring mounted between the first member and second member. The Schar split ring includes teeth that engage grooves on the exterior of the inner member. The split ring acts as a spring, contracting around the inner member when in its normal position, but capable of being forced open to allow the inner member to move axially within the outer member. By contrast, the locking clip of the present application has a normal position that does not engage the inner member of the device, as set forth in Claim 1 by the

language, "moveable between a first unlocked position and a second locked position for locking said first member and said second member in a relative axial position with respect to one another." This allows the surgeon to easily adjust the height of the device. Once the surgeon has determined the desired height, a simple turn of the clip forces the threads of the clip to engage the threads of the inner member. The surgeon is not required to perform two tasks at once during implantation - namely, hold open the clip and axially move the inner member. Since the locking clip is "rotatably mounted" on the exterior of the outer member, the present invention has an additional advantage in that the locking clip is easily accessed and manipulated. Accordingly, independent Claim 1 is not anticipated and is in condition for allowance.

In light of the above-mentioned claim amendments, Claims 2-9, 13-15, 18, 25 and 26 depend directly or indirectly upon Claim 1. Claims 2-9, 13-15, 18, 25 and 26 are not anticipated by *Schar* and are thus allowable for the reasons set forth with respect to Claim 1, as well as by reason of the additional features set forth therein that are not disclosed in the prior art of record.

In view of the foregoing, Applicants respectfully request the Examiner's favorable reconsideration of all claims presently pending in the present application. Applicants believe that each and every claim is allowable over the prior art references of record.

Applicants respectfully and provisionally request that the declaration of a Final Office Action by the Examiner be withdrawn. Of course, if all claims are allowed, this request is moot.

The basis for the request to withdraw the finality is § 706.07 (a) of the Manual of Patent Examining Procedure, which states that a "second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground or rejection not necessitated by amendment of the application by Applicants, whether or not the prior art is already of the record." In the present office action, Studer, U.S. Patent No. 6,193,756, and Schar, WO 98/46173, are both new grounds of rejection for various claims not necessitated by the prior amendment. Indeed, and by way of example, previously allowed Claim 4 was subject to rejection in the second Office Action and therefore amendment could not have necessitated a new rejection because there was no amendment. In this regard, the Examiner did not assert in the Office Action that the new grounds were necessitated by Applicants' amendment.


Should the present amendment not place all claims in condition for allowance, Withdrawal of the Final Office Action would be greatly appreciated.

Should the Examiner have any questions with regard to the foregoing, the Examiner is encouraged to contact the undersigned, at the Examiner's convenience, at 908-654-5000.

Furthermore, should any fee be due and owing in regard, the Examiner is hereby authorized to charge the same to our Deposit Account No. 12-1095.

Respectfully submitted,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK


KEITH E. GILMAN
Reg. No. 32,137

600 South Avenue West
Westfield, NJ 07090
(908) 654-5000
(908) 654-7866 FAX
KEG:

316004_1.DOC